

NSG-210US

Appln. No.: 10/088,275
Amendment Dated December 10, 2003
Reply to Office Action of September 10, 2003

Remarks/Arguments:

Claims 1-9 are pending in the above-identified application claims 10-14 are withdrawn from consideration.

Claims 1-5 were rejected under 35 U.S.C. § 102(b) as being anticipated by Russell et al. This ground for rejection is overcome by the amendment to claim 1. In particular, Russell et al. neither disclose nor suggest "at least one pair of opposing electrodes provided on the resistor layer, wherein the pair of opposing electrodes are configured to provide first and second signals indicative of a position of the incident light on the resistor layer," as required by amended claim 1. Russell et al. concerns a PIN photodiode having a transparent conductor N+ Layer, which eliminates spatial variation in the frequency response of large area PIN photodiodes. While Russell et al. may disclose a resistive layer having a pair of electrodes, it does not disclose or suggest that the pair of electrodes are "configured to provide first and second signals indicative of a position of the incident light on the resistor layer," as required by amended claim 1. Basis for this amendment may be found in the specification at page 6, line 3 through page 7, line 4. Accordingly, claim 1 is not subject to rejection under 35 U.S.C. § 102(b) in view of Russell et al. Claims 2-5 depend from claim 1 and are not subject to rejection under 35 U.S.C. § 102(b) in view of Russell et al. for at least the same reasons as claim 1.

Claims 6 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakama in view of Russell et al. This ground for rejection is respectfully traversed because Nakama is excluded as a prior art reference in the subject application under 35 U.S.C. § 103(c). Nakama issued on May 29, 2001, while the subject application was filed on July 10, 2001, the filing date of a PCT application designating the U.S. is the filing date of the U.S. national phase application resulting from the PCT application (see 35 U.S.C. § 363). Accordingly, Nakama is prior art against the subject application only under 35 U.S.C. § 102(e). 35 U.S.C. § 103(c) expressly excludes a reference that is prior art under 35 U.S.C. § 102(e) from use in a rejection under 35 U.S.C. § 103(a) if the subject matter of the reference and invention were "owned by the same person or subject to an obligation of assignment to the same person" at the time the invention was made. In this instance, the present invention was owned by Nippon Sheet Glass at the time it was made and the Nakama patent is assigned to Nippon Sheet Glass. Because all of the requirements of the statute have been met, Nakama can not be used as a prior art

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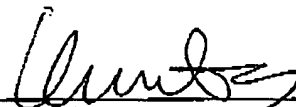
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reference in the subject application. Accordingly, claims 6 and 9 are not subject to rejection under 35 U.S.C. § 103(a) in view of Nakama and Russell et al.

Claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shigeru in view of Russell et al. This ground for rejection is overcome by the amendment to claim 1. In particular, neither Russell et al., Shigeru nor their combination disclose or suggest, "at least one pair of opposing electrodes provided on the resistor layer, wherein the pair of opposing electrodes are configured to provide first and second signals indicative of a position of the incident light on the resistor layer," as required by amended claim 1. Russell et al. is described above. Shigeru concerns a multi-wave spectroscopic photometer. It does not disclose or suggest a structure having a resistive layer with opposing electrodes and, so, can not provide the material that is missing from Russell et al. Accordingly, claims 7 and 8 are not subject to rejection under 35 U.S.C. § 103(a) in view of Shigeru and Russell et al.

In view of the foregoing amendments and remarks, Applicants request that the Examiner reconsider and withdraw the rejection of claims 1-9.

Respectfully submitted,


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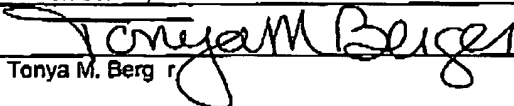
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